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OFFICE OF PETITIONS

In re Application of
Woolston .
Application No. 10/824,322
Filed: April13, 2004
Docket No.:13466-002016

: DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.59 filed June 22, 2005, which is being treated as a petition requesting closure of the document filed by a third party on April 22, 2005.

The petition is granted.

Petitioner requests that the above-mentioned communication filed by eBay be expunged and its contents be disregarded in this Image file Wrapper (IFW) case.

Inspection of USPTO records for this application reveals that it was published as pre-grant publication no. US20050033655A1 on February 10, 2005. Accordingly, for the contested third party communication filed April 22, 2005, to be entered, much less remain in this application record, the controlling regulations, 37 CFR §§ 1.99 or 1.291, must be satisfied.

While self-styled as a petition under 37 CFR 1.182, a cursory review of the eBay communication reveals that it requests that the USPTO take notice of its prior findings alleged to have been arrived at during the course of prosecution of 18 related (common inventorship) patent applications, and that the USPTO apply these findings consistently in the examination of the instant non provisional application. These findings are discussed in conjunction with, *inter alia*, at least 2 specifically mentioned U.S. Patents (the latest of which issued September 2, 1997) , several prior art articles (the latest of which dates from 1995), and assertions as to what the USPTO has held to be well known in the art during the examination of the prior applications. As such, the contested communication may be considered to be either a citation of prior art within the meaning of 37 CFR 1.99, or a protest within the meaning of 37 CFR 1.291, to the issuance of a patent to the instant application.

§ 1.99(d) states that any submission under this section shall not include any explanation of the patents, publications, or other information, and if such is included the USPTO will not enter the submission. While petitioner contends the submission occupies some 53 pages, the document actually subtends some 101 pages herein. Furthermore, the explanation pertaining to the two U.S. patents alone occupies, according to the table of contents, pages 14 through 29; the prior art publications occupies, according to the table of contents, pages 30 through 35, and, of course, the remaining pages of the submission constitute the other information. Facialy,

therefore, the eBay submission contains an extensive explanation of the patents, prior art, and other information, that simply does not comply with § 1.99(d), which prohibits any explanation. Further, the submission facially is untimely within the meaning of § 1.99(e), and given the publication dates of the aforementioned patents and prior art, could clearly have been submitted to the USPTO earlier. Thus, retention of the eBay protest in this published application file is inconsistent with 37 CFR 1.99.

While 37 CFR 1.291 is more liberal than § 1.99(d) in permitting a "concise" explanation of the information relied on, as opposed to precluding any explanation, the protest was untimely filed i.e., filed after publication. Nevertheless it lacks the permission of applicant required by § 1.291(b)(1) for consideration of a protest filed after publication containing even a "concise" explanation. As the eBay protest is facially not concise, and as it lacks, given the instant petition, any semblance of the applicant's written approval, its retention is likewise prohibited under § 1.291. This is particularly so as Congress expressly wrote a statutory prohibition of protests in published applications in 35 U.S.C. § 122(b) in the absence of the express written permission of the applicant.

Accordingly, for the reasons given above, it has been established to the satisfaction of the Director that expungement of the eBay protest is appropriate. The file entry for this document has been closed and as such the document is no longer available to the public for inspection, which is the IFW equivalent to removal of a paper document from a paper file wrapper.

The \$70 balance owed (for a total of \$200) for the petition has been charged to counsel's deposit account.

This application is being referred to the TC for examination in due course

Any inquiries concerning this communication may be directed to the undersigned at (571) 272-3217.



Brian Hearn
Petitions Examiner
Office of Petitions